

REMARKS

Claims 31 – 61 are pending in the application. Claim 38 has been amended to correct the dependency to claim 31 rather than claim 1, a canceled claim. Many of the claims have been amended to emphasize that the actions stored, selected and communicated are expert actions. This does not change any of the claims substantively, because the claims already indicated that the actions were those that an expert would take in response to the physical situation. However, it is believed that it makes the claim read more smoothly because it removes the requirement that the reader think about which actions are being claimed. It is also believed that this will be helpful in providing a consistent reminder to the reader that the action items are not stored history of the user, but discrete actions that an expert would suggest taking in the situation.

Claim Rejections – 35 USC §101

Claims 31 – 61 have been rejected under 35 USC 101 on the grounds that the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner cites 1077 OG 24 as support for this rejection. A copy of this citation is enclosed. This citation does not support the Examiner's position. The claim wording at issue is:

an electronic storage device for storing a plurality of discrete physical factors describing a real or hypothetical situation in said athletic sport and for storing athletic sport action information regarding a plurality of different kinds of discrete actions that an expert that is not said person would take in response to said situation;

First of all, this phrase claims a type of information stored in an electronic storage device. 1077 OG 24 refers to patenting an organism that can read on a human being. The phrase at issue does not refer to an organism, and thus is not the non-statutory subject matter prohibited by the Constitution and the Office Gazette. It is also noted that 1077 OG 24 states, in the context of the human exclusion from patentable subject matter, that "the use of a negative limitation... is a permissible form of expression." Since the phrase at issue is

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a negative limitation, 1077 OG 24 would support the patentability of the claim even if it did refer to an organism.

Claim Rejections – 35 USC §112

Claims 31 -- 61 have been rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed. This rejection appears to be the same rejection as just discussed above, in another form, and is not proper for the same reason. It is also noted that the fact that the discrete action information is that of an expert in the sport is described in detail in the application. See, page 2, line 30 – page 4, line 3; FIGS. 1, 3 and 4 and the descriptions of those figures in the specification at page 6, line 4 through page 12, line 25, and elsewhere in the specification. Thus, the specification is enabling for the type of information that is stored.

Claim Rejections – 35 USC §102

Claims 31 -- 34, 40 -- 42, 46 -- 51, 53 -- 56, and 58 -- 61 have been rejected under 35 USC 102(b) as being anticipated by Fisher (US Patent No. 5,507,485). This rejection is respectfully traversed. With regard to claim 1, Fisher does not disclose an electronic storage device for storing ...a plurality of different kinds of discrete actions that an expert that is not said person would take in response to said situation. Nor does it disclose: a processor...for selecting a plurality of specific discrete expert actions from said action information, or said specific discrete expert actions being automatically selected by said processor when provided with said plurality of discrete physical factors; or an output device for communicating said plurality of specific discrete expert actions to said person.

With regard to claim 56, Fisher does not disclose the method of storing in an electronic memory... athletic sport action information regarding a plurality of different kinds of discrete actions that an expert that is not said person would take in response to said situation or the other processes relating to expert actions. And with regard to claim 58, Fisher does not have "A machine readable storage medium containing instructions for performing a method..., said method including: storing in an electronic memory...sport action information regarding a plurality of different kinds of discrete expert actions that an expert that is not said person would take in response to said situation," or the other

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instructions relating to expert actions. There is a fundamental technical difference between Fisher and the instant invention. Fisher is basically a computer for storing the golf history of a user. The present invention is fundamentally a sport situation analyzer that coaches the user on the best way to play the sport. The only analysis that Fisher does is to compare a current golf physical situation to stored historical situations. If the golfer has never had the same or similar situation while using the computer, the computer is useless. Fisher also requires quite a bit of input by a user before the system becomes useful. There is also a huge practical difference in the two systems. Fisher does not offer any way for the user to improve in the sport, except perhaps by not making the same mistake twice. The system of the invention is about improvement. The above-recited claim elements that Fisher does not have are fundamental to these distinctions. To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) as quoted in the MPEP. Thus, Fisher does not anticipate claims 1, 56 and 58.

Claims 32 -- 34, 40 -- 42, 46 -- 51 and 53 -- 55 depend on claim 1, and claims 59 -- 61 depend on claim 58 and contain all its limitations, and, therefore, are also patentable. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) at headnote 4. In addition, claims 32, 42 and 60 have been amended so they no longer include "shot," so Fisher does not anticipate them on their own merits. Also, Fisher does not disclose an input device for entering a personal tip. While it discloses giving a tip, there is no input device for inputting a tip, but the tip is allegedly derived from personal history (i.e., you need to practice this shot.) So claim 51 is not anticipated on its own merits. Further, all claims elements that contain the term "expert" also are not anticipated by Fisher on their own merits.

Claim Rejections – 35 USC §103

Claims 35 -- 39 have been rejected under 35 USC 103(a) as being unpatentable over Fisher (US Patent No. 5,507,485) in view of Wilens (US Patent No. 5,779,566). This rejection is respectfully traversed.

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The basic reason why the combination of Fisher and Wilens cannot make claims 35 – 39 obvious is that Wilens does not disclose any of the elements of claim 1 discussed above that Fisher does not disclose, namely: an electronic storage device for storing ...a plurality of different kinds of discrete actions that an expert that is not said person would take in response to said situation; a processor...for selecting a plurality of specific discrete expert actions from said action information; said specific discrete expert actions being automatically selected by said processor when provided with said plurality of discrete physical factors; or an output device for communicating said plurality of specific discrete expert actions to said person. The patent law is very clear that to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991). MPEP 2142 and MPEP 2143 – 2143.03.

Further, with regard to claims 35, 36, and 37, Wilens at most only suggests that the aspects of Wilens that have to do with recording and reporting golf data can be applied to "any sport." Wilens, column 16, lines 48 – 53. Suggesting that one can record and report information on tennis using a computer does not teach that the system of claim 1 can be applied to tennis. Likewise for hockey and skiing.

On page 7 regarding claims 38 and 39, the office action uses the knowledge of the current invention to construct an interpretation of Wilens that, though accurate in the individual details, is not accurate with regard to the total impression. The "random access" referred to is only the "random access" as in random access memory. Access is not random in that it is automatic. Rather, the access is made by the user making a selection using a choices key. Col. 8, lines 37 – 46. The only advice that can be given based on data input to the computer is club selection. Club selection is trivial, since there are only about ten possible outcomes. Analytical schemes, such as using a paper chart, have been used for more than fifty years to select clubs based on many factors. The only other advice that Wilens can give is general advice, and this advice is not selected automatically by the system based on physical factors. Rather, the user first selects a game play advice module by pressing a key, then a series of problems (slice, hook, top ball etc.) are

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presented. The user selects one of the problems, and the device then presents general advice on the problem. Col. 13, lines 18 – 27. Further, Wilens does not disclose the specific elements of claims 38 and 39, namely: different groups of specific discrete actions and each group representing the response of a different expert; and an input device for selecting the expert.

Claims 43 – 45, 52, and 57 have been rejected under 35 USC 103(a) as being unpatentable over Fisher (US Patent No. 5,507,485) in view of Baker (US Patent No. 5,486,001). This rejection is respectfully traversed.

Each of claims 43 – 45, 52, and 57 depend on either claim 31 or claim 55, and contain all the limitations of the corresponding base claim. Baker does not suggest any method of deriving discrete actions from physical factors and, thus, it cannot supply what Fisher lacks. Thus, neither Fisher, Baker, nor their combination teach or suggest all of the claim limitations. For this reason, claims 43 – 45, 52 and 57 are patentable. In addition, claims 52 and 57 also include the limitation that the processor (or method) compares a plurality of discrete actions entered by the user to the selected plurality of discrete actions, and provides the expert comment in response to disagreement between the two. This limitation is not shown in Baker, and, thus, claims 52 and 57 are patentable for this reason also.

In view of the remarks herein, claims 31 – 61 are believed to be patentable and their reconsideration and allowance are respectfully requested. No fee is seen to be required. If any fee is required, please charge it to Deposit Account No. 50-1848.

Respectfully submitted,

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